

REMARKS

The above-identified Final Office Action dated September 25, 2007, contained a final rejection of claims 1-25. Claims 1, 17 and 24 have been amended in an effort to **clarify** these claims. Therefore, the Applicants submit that a new search will **not** be required by the Examiner. As such, the foregoing amendments to the claims and the remarks below are intended to place the case in condition for allowance, or alternately in better form for consideration on appeal under 37 CFR 1.116. Thus, it is respectfully requested that the amendments to claim 1 be entered despite the finality of the present rejection.

The Office Action rejected claims 1-5, 8-18 and 21-25 under 35 U.S.C. § 102(e) as allegedly being anticipated by White et al. (U.S. Patent No. 7,035,462). The Office Action rejected claims 6-7 under 35 U.S.C. § 103(a) as allegedly being unpatentable over White et al.

The Applicant respectfully traverses these rejections based on the amendments to the claims and the arguments below.

Specifically, White et al. merely disclose automatically detecting and correcting digital images with eye color defects, such as red-eye. Although the Examiner argued that White et al. disclose "...a counter for counting eye color defects when a selection means 76 is pressed..." and cited to Figs. 6-8, the Applicants respectfully submit that Figs. 6-8 and the corresponding disclosure of White et al. does **not** disclose, teach or suggest **animatedly** performing these functions, like the Applicants' claimed invention. In contrast, the Applicants' claimed invention **animatedly presents** the at least one candidate red-eye region as a magnified view in a center of the display screen **and animatedly updates** the digital image **as the user navigates** to a **different** candidate red-eye region.

Further, with regard to claim 17, although the Examiner argued that White et al. disclose "...an user can indicate rejection of a red-eye candidate and the indicator can take the shape of X mark..." (the Examiner cited to col. 9, lines 23-40), the Applicants respectfully disagree with this interpretation of White et al. In fact, col. 9, lines 23-40 of White et al. **explicitly** disclose "...an indicator or other distinctive mark can be employed to indicate the eye color defect on the digital image which **was corrected**."

That is, an indicator can be employed to indicate the one or more corrected eye color defects in the digital image." [**emphasis added**]. Instead, the Applicants' claimed invention includes using an X mark superimposed through a candidate red-eye region as an indicator not accepted by the user for **uncorrected** defects as a graphical rejection device and not as an indicator for the corrected defects of White et al.

As such, since White et al. do not disclose all of the elements of the claimed invention, White et al. cannot anticipate the claims nor can White et al. render the claims obvious. Hence, the Applicants respectfully submit that the rejections under 35 U.S.C. 102 and 35 U.S.C. 103 should be withdrawn.

Further, even though the combined references do not disclose, teach, or suggest all of the features of the Applicants' claimed invention, the references should not be considered together because White et al. teach away from the Applicants' claimed invention. MPEP section 2143.01, part V. clearly states that "[I]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Also, MPEP section 2143.01, part VI. states that "[I]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Namely, as admitted by the Examiner, White et al. explicitly disclose that the system includes "...an indicator or other distinctive mark can be employed to indicate the eye color defect on the digital image which was corrected. That is, an indicator can be employed to indicate the one or more corrected eye color defects in the digital image." [**emphasis added**] (see col. 9, lines 23-40 of White et al.). The indicator for **corrected** defects is in White et al. is required for proper operation. In contrast, the Applicants' claimed invention uses an X mark superimposed through a candidate red-eye region not accepted by the user for **uncorrected** defects as a graphical rejection device and not as an indicator for the corrected defects of White et al.

Consequently, the proposed modification or combination would render White et al. being modified unsatisfactory for its intended purpose and would change the

principle of operation of the invention in White et al. being modified. This is because White et al. explicitly **require** the indicator for **corrected** defects, **unlike** the Applicants' claimed invention which uses an indicator for **uncorrected** defects as a graphical rejection device.

Therefore, this "teaching away" prevents this reference from being used by the Examiner. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, since the Applicant's claimed elements are **not** disclosed, taught or suggested by the combined references and because White et al. **teach away** from the Applicants' invention, White et al. **cannot** be used as a reference alone or in combination with other references, and hence, the Applicant submits that the rejection should be withdrawn. *MPEP* 2143.

Also, the Examiner is reminded that these references **should not** be considered together with the benefit of hindsight. It is well-settled in the law that improper hindsight occurs when knowledge and advantages from the Applicant's disclosure is used or words or phrases are arbitrarily picked and chosen from references to recreate the Applicant's invention. Crown Operations International, Ltd. v. Solutia, Inc., 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In particular, the combination of elements in a manner that reconstructs the Applicant's invention only with the benefit of **hindsight** is insufficient to present a prima facie case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Even if the references in question seem relatively similar "... **the opportunity to judge by hindsight is particularly tempting**. Hence, the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses a reference that does not explicitly disclose the exact elements of the invention or **teaches away** from the Applicant's claimed invention, which is the case here. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). Since hindsight cannot be used to support the rejections, the combined cited references cannot render the Applicant's invention obvious and the rejection is improper and should be withdrawn. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc. Accordingly, this teaching away and the failure of the cited references to disclose, suggest or provide

motivation for the Applicant's claimed invention indicates a lack of a prima facie case of obviousness (MPEP 2143).

Last, with regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (MPEP § 2143.03).

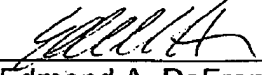
As the foregoing amendments to the claims do not raise new issues, it is the Applicant's position that they are entitled to have the changes entered to place this case in condition for allowance, or alternately, in better condition for consideration on appeal under 37 CFR 1.116. It is, therefore, respectfully requested that the changes to the claims be entered despite the finality of the present rejection.

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly requests the Examiner to telephone the Applicant's attorney at **(818) 885-1575**.

Please note that all mail correspondence should continue to be directed to

Hewlett Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

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Edmond A. DeFrank
Reg. No. 37,814
Attorney for Applicant
(818) 885-1575 TEL
(818) 885-5750 FAX